

Application No.: 09/870,672
Attorney's Docket No.: MA3005-0031

REMARKS

Favorable reconsideration of this application and entry of this Amendment is respectfully requested in view of the above amendments to the claims and following remarks.

Summary of Office Action

In the July 14, 2004 Office Action, claims 1, 5, 6, 10, 20, 32, 35 and 36 were rejected under 35 U.S.C. §102(e) over Palmaz et al. WO 99/23977 (Palmaz'977); claims 4, 7, 9, and 11-13 were rejected under 35 U.S.C. §103(a) over Palmaz'977; claims 14-19 were rejected under 35 U.S.C. §103(a) over Palmaz'977 in view of U.S. Patent No. 5,876,449 to Alt et al. (Alt'449); claims 2, 21-25, 33, 34 and 37 were rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,293,967 to Shanley (Shanley'967) in view of Palmaz'977; and claims 27-31 were rejected under 35 U.S.C. §103(a) over Shanley'967 in view of Palmaz'977 and further in view of Alt'449.

Summary of Response to Office Action

By this Amendment, Claims 1, 32, and 33 have been amended and claims 2, 6, 7, 21 and 24-31 have been canceled without prejudice or disclaimer. Claims 3 and 8 were canceled in prior Amendments. Thus, the claims currently pending in this application are claims 1, 4, 5 and 9-20, 22, 23, and 32-37. Claims 1, 32, and 33 are the only independent claims.

Pending Claims Define Allowable Subject Matter

In the July 14, 2004 Office Action, claims 1, 5, 6, 10, 20, 32, 35 and 36 were rejected under 35 U.S.C. §102(e) over Palmaz'977. This rejection is respectfully traversed for the following reasons.

Palmaz'977 discloses an Intravascular Stent in which at least one groove is disposed on the inner surface of the stent to promote the migration of endothelial cells. However, Palmaz'977 fails to disclose or teach at least the feature of an implantable tubular device

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having a deformable portion formed on a peripheral surface thereof...and when the deformable portion is prolonged it forms an endless annular configuration, as recited in independent claim 1. Furthermore, Palmaz'977 fails to disclose or teach at least the feature of deformable portions that are formed on the bent portions of the wavy annular members such that the deformable portions are substantially parallel with one another, as also recited in claim 1.

With regard to independent claim 32, Palmaz'977 fails to disclose or teach at least the feature of deformable portions forming a predetermined angle with respect to the axial direction of the device, and when a deformable portion is prolonged it forms a spiral configuration, as recited in independent claim 32.

Claims 5, 6, 10, 20 and 35 are dependent from claim 1 and include all the features of claim 1, and claim 36 is dependent from claim 32 and includes all the features of claim 32 therein. Accordingly, Palmaz'977 also fails to disclose each and every feature of claims 5, 6, 10, 20, 35 and 36 for at least the reasons set forth above with respect to their respective parent claims 1 and 32, and because of the separate and distinct features that claims 5, 6, 10, 20, 35, and 36 recite.

Palmaz'977 fails to disclose or teach each and every element as set forth in claims 1, 5, 6, 10, 20, 32, 35 and 36, either expressly or inherently. Accordingly, it is respectfully submitted that these claims are allowable, and that the rejection cannot be maintained. Withdrawal of the rejection under 35 U.S.C. §102(e) over Palmaz'977 is respectfully requested.

Claims 4, 7, 9, and 11-13 were rejected under 35 U.S.C. §103(a) over Palmaz'977. This rejection is traversed for the following reasons.

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Applicant respectfully traverses the rejection because the rejection fails to set forth a *prima facie* case of obviousness. The Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicant is under "no obligation to submit evidence of nonobviousness," such as unexpected results or commercial success. *Id.* In other words, if the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, then that claim is not obvious without any evidence of nonobviousness by Applicant.

In order to establish a *prima facie* case of obviousness, the Office must satisfy three requirements. M.P.E.P. § 2142. First, "the prior art reference, or references when combined, must teach or suggest *all* the claim limitations." *Id.* (emphasis added). Second, the Office must show that there is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." *Id.* Finally, "there must be a reasonable expectation of success." *Id.*

In the present case, Palmaz'977 neither teaches nor suggests at least the feature of an implantable tubular device having a deformable portion formed on a peripheral surface thereof...and when the deformable portion is prolonged it forms an endless annular configuration, as recited in independent claim 1. Palmaz'977 also fails to disclose or teach at least the feature of deformable portions that are formed on the bent portions of the wavy annular members such that the deformable portions are substantially parallel with one another, as also recited in claim 1. Thus, the Office Action fails to establish a *prima facie* case of obviousness as to 4, 7, 9, and 11-13 which are all dependent from and include the features of claim 1.

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Further, the Office Action attempts to provide a motivation for modifying Palmaz'977 by indicating that the claimed features are an obvious design choice. However, the Office Action fails to show that one of ordinary skill in the art would have reasonably expected success by modifying Palamaz'977 as suggested by the Office Action. It should be noted that the grooves in Palmaz'977 are to promote the migration of endothelial cells. Accordingly, there would have been no motivation to modify Palmaz'977 to arrive at the presently claimed invention but for using Applicant's claims as a roadmap for alleging this "design choice." This is the exact definition of the use of impermissible hindsight. Accordingly, it is respectfully submitted that no motivation existed to change the Palmaz'977 reference as described in the outstanding Office Action.

The Office Action fails to meet the three requirements for establishing a *prima facie* case of obviousness. Therefore, Applicant respectfully requests that the rejection of claims 4, 7, 9, and 11-13 under 35 U.S.C. § 103(a) be withdrawn.

Claims 14-19 were rejected under 35 U.S.C. §103(a) over Palmaz'977 in view of Alt'449. This rejection is respectfully traversed for the following reasons.

Alt'449 fails to make up for the above-noted deficiencies of Palmaz'977. In particular, Alt'449 fails to disclose or teach at least the feature of an implantable tubular device having a deformable portion formed on a peripheral surface thereof...and when the deformable portion is prolonged it forms an endless annular configuration, as recited in independent claim 1. Alt'449 also fails to disclose or teach at least the feature of deformable portions that are formed on the bent portions of the wavy annular members such that the deformable portions are substantially parallel with one another, as also recited in claim 1. Claims 14-19 depend from claim 1 and include all the features of claim 1. Accordingly, claims 14-19 are allowable because of the above-noted features that are neither taught nor disclosed in either

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Palmaz'977 or Alt'449 (either alone or in combination), and for the additional features that claims 14-19 recite. In addition, as outlined above, there is no motivation to modify the Palmaz'977 reference as described in the outstanding Office Action. Accordingly, withdrawal of the rejection under 35 U.S.C. §103(a) over Palmaz'977 in view of Alt'449 is respectfully requested.

Claims 2, 21-25, 33, 34 and 37 were rejected under 35 U.S.C. §103(a) over Shanley'967 in view of Palmaz'977. The rejection is respectfully traversed for the following reasons.

Claims 2, 21, 24, and 25 have been canceled without prejudice or disclaimer by this Amendment. Claim 22 has been amended to depend from independent claim 1. Accordingly, the rejection of claims 2 and 21-25 is now moot.

With regard to claims 33, 34 and 37, it is respectfully submitted that neither Shanley'967 nor Palmaz'977, either alone or in combination, disclose or teach at least the feature of an implantable tubular device having a plurality of deformable portions formed on a peripheral surface of the tubular device, with the deformable portions forming a predetermined angle with respect to an axial direction of the tubular device, and when the deformable portion is prolonged it forms an endless annular configuration, as recited in claim 33. Nor does Shanley'967 or Palmaz'977, either alone or in combination, disclose or teach at least the feature of deformable portions formed on the bent portions of the wavy annular members such that the deformable portions are substantially parallel with one another, as recited in claim 33. Claims 34 and 37 depend from claim 33 and therefore include all of the above distinguishing features of claim 33. In addition, as outlined above, there would have been no motivation to combine the Shanley'967 and Palmaz'977 references. No *prime facie* case of obviousness exists.

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Because Shanley'967 and Palmaz'977 fail to disclose, either alone or in combination, all the features of claims 33, 34 and 37, and because there is no motivation to combine these references as suggested in the Office Action, it is respectfully submitted that claims 33, 34, and 37 are allowable. Withdrawal of the rejection under 35 U.S.C. §103(a) over Shanley'967 in view of Palmaz'977 is respectfully requested.

Claims 27-31 were rejected under 35 U.S.C. §103(a) over Shanley'967 in view of Palmaz'977 and further in view of Alt'449. This rejection is traversed for the following reasons.

By entry of this Amendment, claims 27-31 are canceled without prejudice or disclaimer. Accordingly, the rejection of claims 27-31 is moot, and withdrawal of the rejection is respectfully requested.

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Conclusion

It is respectfully submitted that the amendments to the claims and the cancellation of certain claims without prejudice or disclaimer places this case in immediate and clear form for allowance and/or in better form for appeal. Accordingly, entry of the amendment and an early indication via a Notice of Allowability that all claims are allowable are respectfully requested. Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-2985. If a fee is required for an extension of time under 37 C.F.R. § 1.136 is not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account No. 50-2985.

Respectfully submitted,

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